



ZFW

P A T E N T

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Tenebaum et al.

Application No.: 10/785,315

Filed: February 23, 2004

For: **METHODS AND APPARATUS FOR PROVIDING PRINTING SERVICES BY
ASSIGNING A TELEPHONE NUMBER TO A PRINTER**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on May 28, 2004.

By: Carol Prentice
Carol Prentice

INFORMATION DISCLOSURE STATEMENT

Dear Sir:

In accordance with 37 C.F.R. §1.56, Applicants wish to call the attention of the Examiner to the following references:

U.S. PATENT/PUBLICATIONS(S) :

| <u>Patent/Pub. No.</u> | <u>Patentee/Inventor</u> | <u>Date of Issue/Pub.</u> |
|------------------------|--------------------------|---------------------------|
| 5,287,194 | Lobiondo | Feb 15, 1994 |
| 5,450,571 | Rosekrans et al. | Sep 12, 1995 |
| 5,559,933 | Boswell | Sep 24, 1996 |
| 5,625,757 | Kageyema | Apr 29, 1997 |
| 5,727,135 | Webb et al. | Mar 10, 1998 |
| 5,727,156 | Herr-Hoyman | Mar 10, 1998 |
| 5,799,206 | Kitagawa | Aug 25, 1998 |
| 5,802,260 | Shimakawa | Sep 01, 1998 |
| 5,881,213 | Shaw et al. | Mar 09, 1999 |

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /A.T./

| | | |
|--------------|--------------------|--------------|
| 5,898,823 | Sorkin | Apr 27, 1999 |
| 5,978,560 | Tan et al. | Nov 02, 1999 |
| 5,982,994 | Mori et al. | Nov 09, 1999 |
| 5,987,224 | Koakutsu et al. | Nov 16, 1999 |
| 5,995,723 | Sperry | Nov 30, 1999 |
| 6,003,069 | Cavill | Dec 14, 1999 |
| 6,006,281 | Edmunds | Dec 21, 1999 |
| 6,012,083 | Savitzky et al. | Jan 04, 2000 |
| 6,023,345 | Bloomfield | Feb 08, 2000 |
| 6,023,684 | Pearson | Feb 08, 2000 |
| 6,025,931 | Bloomfield | Feb 15, 2000 |
| 6,043,909 | Holub | Mar 28, 2000 |
| 6,043,898 | Jacobs | Mar 28, 2000 |
| 6,094,679 | Teng et al. | Jul 25, 2000 |
| 6,125,372 | White | Sep 26, 2000 |
| 6,240,456 | Teng et al. | May 29, 2001 |
| 6,288,790 | Yellepeddy et al. | Sep 11, 2001 |
| 6,298,445 | Shostack et al. | Oct 02, 2001 |
| 6,307,640 | Motegi | Oct 23, 2001 |
| 2001/0037462 | Bengtson | Nov 01, 2001 |
| 6,327,045 | Teng et al. | Dec 04, 2001 |
| 6,334,142 | Newton et al. | Dec 25, 2001 |
| 6,337,745 | Aiello, Jr. et al. | Jan 08, 2002 |
| 6,351,317 | Sasaki et al. | Feb 26, 2002 |
| 6,378,070 | Chan et al. | Apr 23, 2002 |
| 6,405,178 | Manchala et al. | Jun 11, 2002 |
| 6,466,328 | Bradley et al. | Oct 15, 2002 |
| 6,490,052 | Yanagidaira | Dec 03, 2002 |

| | | |
|-----------|----------------|--------------|
| 6,615,234 | Adamske et al. | Sep 02, 2003 |
| 6,623,527 | Hamzy | Sep 23, 2003 |
| 6,625,642 | Naylor, et al. | Sep 23, 2003 |

FOREIGN PATENT DOCUMENTS

| <u>Country</u> | <u>No.</u> | <u>Date of Publication</u> |
|-----------------------|-------------------|-----------------------------------|
| Japan | 2000-155733 | Jun 06, 2000 |
| Germany | 196 41 357 | Apr 09, 1998 |
| EPO | 0 910 203 | Apr 21, 1999 |
| EPO | 0 952 513 | Oct 27, 1999 |
| EPO | 0 974 892 | Jan 26, 2000 |
| EPO | 0 598 513 | May 25, 1994 |
| EPO | 1 026 576 | Aug 09, 2000 |
| EPO | 0 977 113 | Feb 02, 2000 |
| EPO | 0 974 890 | Jan 26, 2000 |
| EPO | 0 872 792 | Oct 21, 1998 |
| EPO | 0 991 227 | Apr 05, 2000 |

PUBLICATIONS:

Web Pages from hpwire.com web site, including white paper entitled "HP Wire: Enabling E-Printing Solutions for the Enterprise," by Lim Chuin Kiat and Wilson Wong (undated), printed from the web site on January 16, 2001 (8 pages total).

PrinterOn Corporation Products and Solutions white paper, by Patrick Pidduck, July 27, 2000 (13 pages).

Web page from kinkos.com web site, printed from the web site on January 16, 2001 (1 page).

Web pages from weborder.kinkos.com web site, printed from the web site on January 16, 2001 (4 pages).

Copies of the above-listed foreign and non-patent references are enclosed, together with a completed form PTO-1449.

English language abstracts are attached to the enclosed copies of JP 2000-155733 and DE 196 41 357. A full English translation is also provided for JP 2000-155733.

Consideration of these references by the Examiner is respectfully requested. To date, a first Office Action on the merits has not been received in connection with this application. This Information Disclosure Statement is therefore believed to be timely filed.


The submission of the listed documents is not intended as an admission that any such document constitutes prior art against the claims of the present application. Applicants do not waive any right to take any action that would be appropriate to antedate or otherwise remove any listed document as a competent reference against the claims of the present application.

Respectfully submitted,



Douglas M. McAllister
Attorney for Applicant(s)
Registration No. 37,886
Law Office of Barry R. Lipsitz
755 Main Street, Bldg. 8
Monroe, CT 06468
(203) 459-0200

Date: May 28, 2004
ATTORNEY DOCKET NO.: EFI-209

| FORM PTO-1449 | |  | | ATTY. DOCKET NO.: EFI-209 | | SERIAL NO.: 10/785,315 | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|------------|---------------------------------------|-------|-------------------------------|----------------------------|
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT | | | | APPLICANT(S): Tenebaum et al. | | | |
| | | | | FILING DATE: February 23, 2004 | | GROUP: | |
| U.S. PATENT DOCUMENTS | | | | | | | |
| EXAMINER INITIAL | | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB- CLASS | FILING DATE |
| | AA | 5,287,194 | 02/15/1994 | Lobiondo | | | |
| | AB | 5,450,571 | 09/12/1995 | Rosekrans, et al. | | | |
| | AC | 5,559,933 | 09/24/1996 | Boswell | | | |
| | AD | 5,625,757 | 04/29/1997 | Kageyema | | | |
| | AE | 5,727,135 | 03/10/1998 | Webb, et al. | | | |
| | AF | 5,727,156 | 03/10/1998 | Herr-Hoyman | | | |
| | AG | 5,799,206 | 08/25/1998 | Kitagawa | | | |
| | AH | 5,802,260 | 09/01/1998 | Shimakawa | | | |
| | AI | 5,881,213 | 03/09/1999 | Shaw, et al. | | | |
| | AJ | 5,898,823 | 04/27/1999 | Sorkin | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | |
| | | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB- CLASS | TRAN- SLATION YES NO |
| | AK | 2000-155733 | 06/06/2000 | Japan | | | |
| | AL | 196 41 357 | 04/09/1998 | Germany | | | |
| | AM | 0 910 203 | 04/21/1999 | EPO | | | |
| | AN | 0 952 513 | 10/27/1999 | EPO | | | |
| | AO | 0 974 892 | 01/26/2000 | EPO | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.) | | | | | | | |
| | AP | Web Pages from hpwire.com web site, including white paper entitled "HP Wire: Enabling E-Printing Solutions for the Enterprise," by Lim Chuin Kiat and Wilson Wong (undated), printed from the web site on January 16, 2001 (8 pages total). | | | | | |
| | AQ | PrinterOn Corporation Products and Solutions white paper, by Patrick Pidduck, July 27, 2000 (13 pages). | | | | | |
| | AR | Web page from kinkos.com web site, printed from the web site on January 16, 2001 (1 page). | | | | | |
| EXAMINER | | | | DATE CONSIDERED | | | |
| EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | | | | | | | |

| FORM PTO-1449 | | | | ATTY. DOCKET NO.: EFI-209 | | SERIAL NO.: 10/785,315 | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|-------------------------------------------------------------------------------------------------------|------------|---------------------------------------|-------|----------------------------------|----------------------------|
| INFORMATION DISCLOSURE STATEMENT BY APPLICANT | | | | APPLICANT(S): Tenebaum et al. | | | |
| | | | | FILING DATE: February 23, 2004 | | GROUP: | |
| U.S. PATENT DOCUMENTS | | | | | | | |
| EXAMINER INITIAL | | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB- CLASS | FILING DATE |
| | AS | 5,978,560 | 11/02/1999 | Tan, et al. | | | |
| | AT | 5,982,994 | 11/09/1999 | Mori, et al. | | | |
| | AU | 5,987,224 | 11/16/1999 | Koakutsu et al. | | | |
| | AV | 5,995,723 | 11/30/1999 | Sperry | | | |
| | AW | 6,003,069 | 12/14/1999 | Cavill | | | |
| | AX | 6,006,281 | 12/21/1999 | Edmunds | | | |
| | AY | 6,012,083 | 01/04/2000 | Savitzky et al. | | | |
| | AZ | 6,023,345 | 02/08/2000 | Bloomfield | | | |
| | BA | 6,023,684 | 02/08/2000 | Pearson | | | |
| | BB | 6,025,931 | 02/15/2000 | Bloomfield | | | |
| | BC | 6,043,909 | 03/28/2000 | Holub | | | |
| | BD | 6,043,898 | 03/28/2000 | Jacobs | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | |
| | | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB- CLASS | TRANS- LATION YES NO |
| | BE | 0 598 513 | 05/25/1994 | EPO | | | |
| | BF | 1 026 576 | 08/09/2000 | EPO | | | |
| | BG | 0 977 113 A2 | 02/02/2000 | EPO | | | |
| | BH | 0 974 890 A2 | 01/26/2000 | EPO | | | |
| | BI | 0 872 792 A2 | 10/21/1998 | EPO | | | |
| | BJ | 0 991 227 A2 | 04/05/2000 | EPO | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.) | | | | | | | |
| | BK | Web pages from weborder.kinkos.com web site, printed from the web site on January 16, 2001 (4 pages). | | | | | |
| | | | | | | | |
| | | | | | | | |
| EXAMINER | | | | DATE CONSIDERED | | | |
| EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | | | | | | | |

| FORM PTO-1449 | | | | ATTY. DOCKET NO.: EFI-209 | | SERIAL NO.: 10/785,315 | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|--------------------|------------|---------------------------------------|-------|----------------------------------|----------------------------|
| <u>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</u> | | | | APPLICANT(S): Tenebaum et al. | | | |
| | | | | FILING DATE: February 23, 2004 | | GROUP: | |
| U.S. PATENT DOCUMENTS | | | | | | | |
| EXAMINER INITIAL | | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB- CLASS | FILING DATE |
| | BL | 6,094,679 | 07/25/2000 | Teng et al. | | | |
| | BM | 6,125,372 | 09/26/2000 | White | | | |
| | BN | 6,240,456 | 05/29/2001 | Teng et al. | | | |
| | BO | 6,288,790 | 09/11/2001 | Yellepeddy et al. | | | |
| | BP | 6,298,445 | 10/02/2001 | Shostack et al. | | | |
| | BQ | 6,307,640 | 10/23/2001 | Motegi | | | |
| | BR | 2001/0037462 | 11/01/2001 | Bengtson | | | |
| | BS | 6,327,045 | 12/04/2001 | Teng et al. | | | |
| | BT | 6,334,142 | 12/25/2001 | Newton et al. | | | |
| | BU | 6,337,745 | 01/08/2002 | Aiello, Jr. et al. | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | |
| | | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB- CLASS | TRAN- SLATION YES NO |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.) | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| EXAMINER | | | | DATE CONSIDERED | | | |
| EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | | | | | | | |

| FORM PTO-1449 INFORMATION DISCLOSURE STATEMENT BY APPLICANT | | | | ATTY. DOCKET NO.: EFI-209 | | SERIAL NO.: 10/785,315 | |
|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|----|--------------------|------------|---------------------------------------|-------|----------------------------------|----------------------------|
| | | | | APPLICANT(S): Tenebaum, et al. | | | |
| | | | | FILING DATE: February 23, 2004 | | GROUP: | |
| U.S. PATENT DOCUMENTS | | | | | | | |
| EXAMINER INITIAL | | DOCUMENT NUMBER | DATE | NAME | CLASS | SUB- CLASS | FILING DATE |
| | BV | 6,351,317 | 02/26/2002 | Sasaki et al. | | | |
| | BW | 6,378,070 | 04/23/2002 | Chan et al. | | | |
| | BX | 6,405,178 | 06/11/2002 | Manchala et al. | | | |
| | BY | 6,466,328 | 10/15/2002 | Bradley et al. | | | |
| | BZ | 6,490,052 | 12/03/2002 | Yanagidaira | | | |
| | CA | 6,615,234 | 09/02/2003 | Adamske et al. | | | |
| | CB | 6,623,527 | 09/23/2003 | Hamzy | | | |
| | CC | 6,625,642 | 09/23/2003 | Naylor, et al. | | | |
| | | | | | | | |
| | | | | | | | |
| FOREIGN PATENT DOCUMENTS | | | | | | | |
| | | DOCUMENT NUMBER | DATE | COUNTRY | CLASS | SUB- CLASS | TRAN- SLATION YES NO |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| OTHER DOCUMENTS (Including Author, Title, Date, Pertinent Pages, etc.) | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| | | | | | | | |
| EXAMINER | | | | DATE CONSIDERED | | | |
| EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | | | | | | | |